

"Patent"

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	§	Case Docket No.: 93A007
Deckman, et al.	§	Int'l App. No.: PCT/EP94/01301
Serial No.: 08/545,707	§	Group Art Unit: (unassigned)
Int'l App. Filed: April 25, 1994	§	Examiner: (unassigned)
For: Molecular Sieve Layers and	§	
Processes for Their Manufacture	§	

Honorable Commissioner of Patents and Trademarks
Washington, D. C. 20231

PETITION TO REVIVE UNDER 37 C.F.R. § 1.137(b) AND 37 C.F.R. § 1.183

Dear Sir:

- (1) Applicants respectfully petition the Honorable Commissioner of Patents and Trademarks to revive the above-identified application under 37 C.F.R. 1.137 (b) for the purpose of prosecuting the application. The application became abandoned on October 24, 1995 because of the nonpayment of the U.S. Basic National Fee within the prescribed time.
- (2) Since the application has been abandoned for over one (1) year, this is a Petition to Revive under both 37 C.F.R. 1.137(b) and 37 C.F.R. 1.183. Included with this petition are the U.S. Basic National Fee, the two petition fees as set forth in 37 C.F.R. 1.17(m) [one for the Petition under Rule 137(b) and the other under Rule 183], and a terminal disclaimer with fee under 37 C.F.R. 1.321 dedicating to the public the terminal part, equivalent to the period of abandonment, of any patent granted on the application or on any continuing application entitled under 35

U.S.C. 120 to the benefit of the filing date of the application. An executed Declaration will be provided shortly. Signatures are in process from the twelve (12) inventors, seven (7) of which are located outside the United States.

The facts and circumstances surrounding the unintentional abandonment are as follows:

- (3) The above-identified application was filed as an international application designating the United States. The international application was assigned International Application No. PCT/EP94/01301 ("PCT Application") and given an international filing date of April 25, 1994. The PCT Application claims priority from European Patent Application 93303187.4 ("93 European Application"), filed April 23, 1993.
- (4) The '93 European Application was drafted and filed (with United States Patent and Trademark Office foreign filing license No. 504322) by outside counsel located in London, England. The PCT Application was prepared and prosecuted by P. C. Bawden, a European Patent Attorney located at the Assignee's Abingdon, England, Law Technology Office of the Assignee's United Kingdom affiliate company (Exxon Chemical Limited). Subsequently, the PCT Application became the responsibility of N. J. White, another European Patent Attorney located at the Abingdon Office. The due date for entry of the PCT Application into the U.S. National Phase was October 23, 1995. Following the standard practice of the Abingdon Law Technology Office, the papers for entry of the PCT Application into the U.S. National Phase were sent by courier to the Assignee's Baytown, Texas, Law Technology Office of the Assignee's U.S. affiliate company (Exxon Chemical Company, a division of Exxon Corporation) at least five (5) days before the due date, i.e., October 18, 1995. These papers were received by the Baytown Office one (1) day after the due date, i.e., October 24, 1995. Exhibit A, attached hereto, is a copy of the October 18, 1995 letter which accompanied the papers showing the October 24, 1995 date of receipt.

- (5) After receipt, the papers were delivered to Applicants' attorney. Applicants' attorney, who has been for several years and is currently located at the Baytown Office, is responsible for United States prosecution of applications relating to "zeolite membranes" (the subject matter of the unintentionally abandoned application). After reviewing the papers, Applicants' attorney was concerned that the Basic National Fee for the U.S. National Phase of the PCT-Based Application may not have been paid within thirty (30) months. Therefore, Applicants' attorney instructed the Baytown Law Technology Office's Formalities Paralegal to prepare two separate sets of papers and file each set at the United States Patent and Trademark Office. The first set of papers (relating to the "PCT-Based Application") contained a Transmittal Letter claiming its relationship with the PCT Application (and hence priority from the '93 European Application via the PCT Application). The second set of papers was intended to be filed as a new application with the same specification and claims as the PCT-Based Application, but without any priority claim ("New Application"). The purpose of the New Application (filed less than 12 months after publication of the PCT Application) was to ensure that an active application was pending at the United States Patent and Trademark Office during the time that the status of the PCT-Based Application was being determined. Both sets of papers were mailed to the United States Patent and Trademark Office on November 7, 1995. The United States Patent and Trademark Office assigned the PCT-Based Application Serial Number 08/545,707 and the New Application Serial Number 08/554,879.
- (6) On January 24, 1996, a Notice to File Missing Parts of Application (PTO-1533) having a mailing date of January 17, 1996 was received for the New Application by the Baytown Office. Upon receipt of the Notice, the Docket Clerk at Baytown recorded in the Office's Master Docket that a Declaration was due on February 17, 1996 (extendible to June 17, 1996).

- (7) On February 15, 1996, a Notification of Abandonment for the PCT-Based Application having a mailing date of February 9, 1996, for failure to provide the U.S. Basic National Fee by 30 months was received by the Baytown Office. Upon receipt of the Notification of Abandonment, the Docket Clerk at Baytown, Texas recorded in the Office's Master Docket that a Petition to Revive with the Basic National Fee was due on March 8, 1996 for the PCT-Based Application.
- (8) Before the end of February 1996, Applicants' attorney began preparing a Petition to Revive under 37 C.F.R. 1.137 (b) for the PCT-Based Application. Because an executed Declaration was needed with the payment of the Basic National Fee to revive the PCT-Based Application and had not been received at the Baytown Office, Applicants' attorney instructed personnel responsible for obtaining documents for the PCT-Based Application to obtain a Declaration signed by all inventors for submission with the Petition to Revive. Unknown to Applicants' attorney, the Master Docket was not amended to reflect that a Declaration was needed in addition to the Basic National Fee for the Petition to Revive for the PCT-Based Application.
- (9) On April 11, 1996, the Abingdon Office sent to the Baytown Office a signed Declaration for the PCT-Based Application. Since the Master Docket stated that a Declaration was needed for the New Application (but did **not** show that a Declaration was needed with the Petition to Revive for the PCT-Based Application), the Declaration was inadvertently filed at the United States Patent and Trademark Office for the New Application instead of the PCT-Based Application.
- (10) After receipt of the Declaration, the United States Patent and Trademark Office issued a Filing Receipt for the New Application (copy attached as Exhibit B), which was received by the Baytown Office on June 13, 1996. **That Filing Receipt acknowledged a priority claim from the '93 European**

Application. The priority claim on the Filing Receipt was not correct because the New Application was filed without a claim for priority.

- (11) In June 1997, Susan Mohnke, the Paralegal in the Baytown Office responsible for obtaining documents and reporting/monitoring due dates for United States applications related to zeolite membranes, reviewed both the PCT-Based Application and New Application. In a June 20, 1997 memorandum (copy attached as Exhibit C), Susan Mohnke informed Applicants' attorney, M. J. Dew [Patents Manager], and N. J. White, that the Petition to Revive for the PCT-Based Application had not been filed and that the Filing Receipt for the New Application (Application Serial No. 08/554,879, filed November 7, 1995 and entitled "Molecular Sieve Layers and Processes for Their Manufacture") showed a priority claim from the '93 European Application.
- (12) Applicants' attorney had not received any docket notices since March, 1996 that indicated that the PCT-Based Application had an outstanding Office Action. Therefore, after receipt of the Mohnke memorandum, Applicants' attorney immediately reviewed the files of both the PCT-Based Application and the New Application. The review confirmed that the PCT-Based Application was not pending and that the Filing Receipt for the New Application incorrectly showed priority from the '93 European Application.
- (13) The New Application and the PCT-Based Application have very similar serial numbers (08/545,707 versus 08/554,879), the same titles (Molecular Sieve Layers and Processes for Their Manufacture), the same filing dates (November 7, 1995), the same Attorney Docket Numbers (93A007), the same specifications, and the same claims. Because of all of these similarities and the incorrect acknowledgment of a priority claim on the Filing Receipt, the Baytown Office assumed that all was in order for protecting the subject invention. The Paralegal responsible for reporting patent formality matters to Applicants' attorney did not understand that the New Application could not claim priority from the '93

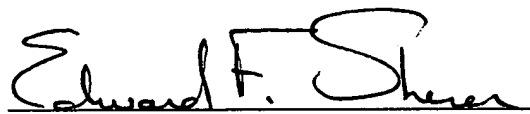
European Application even though its Filing Receipt so indicated. This misunderstanding reasonably led her to assume that the New Application with its priority claim to the '93 European Application was equivalent to the then pending PCT-Based Application. As a result of the misunderstanding, which was based on the incorrect Filing Receipt, the Paralegal did not communicate to Applicants' attorney that a Petition to Revive was still outstanding on the PCT-Based Application. Furthermore, no Docket reminders were generated for other actions on the PCT-Based Application because of the failure to enter on the Master Docket that a Declaration was needed with the Petition to Revive (See paragraph (8) and (9)). Hence the present application did not come to the attention of the Applicants' attorney until the events discussed in paragraph (11).

- (14) It is submitted that the facts and circumstances set forth above fall within the conditions for waiving the 1 year period requirement for reviving an abandoned application under 35 C.F.R. 1.137(b) and that the Commissioner should exercise his authority under 37 C.F.R. 1.183 in this extraordinary situation where justice requires waiver of the 1 year period requirement. Applicants filing of the New Application clearly shows that the Applicants' intent has always been to prosecute a U.S. application directed to the subject matter of the PCT Application. In view of the Terminal Disclaimer filed with this petition, Applicants gain no advantage from having the New Application go abandoned if the petition is indeed granted and the PCT-Based Application is revived.
- (15) As set forth in Article 711.03 of the MPEP, the Commissioner will exercise his authority under 37 C.F.R. 1.183 to waive the one year period requirement for filing a petition pursuant to 37 C.F.R. 1.137(b) provided the conditions identified in Article 711.03 as (1) through (4) are met. With regard to conditions (1) and (2), Applicants' failure to file the Petition to Revive for the present application (i.e., the PCT-Based Application) was clearly an unintentional oversight and a documented Official act of the Office, i.e., the issuance of a Filing Receipt for the

New Application that incorrectly indicated a claim of priority to the PCT Application, was a contributing factor in the Applicants' failure to undertake actions to keep the present application (the PCT-Based Application) alive and subsequently to realize the true abandoned status of the present application. As required by condition (3), this Petition under 37 C.F.R. 1.183 is being promptly filed after Applicants' becoming aware of the true abandoned status of the application, i.e., within 2 months. Enclosed with this petition as required by condition (4) is a terminal disclaimer with fee under 37 C.F.R. 1.321 dedicating to the public a terminal part, equivalent to the period of abandonment, of any patent granted on the application or on any patent entitled under 35 U.S.C. 120 to the benefit of the filing date of the application.

- (16) It is respectfully requested that that the application be revived under 37 C.F.R. 1.137(b) and the Basic National Fee and Declaration be accepted.
- (17) The Commissioner is further authorized to charge any fees necessary to revive this application to deposit account 05-1712.

Respectfully submitted,

A handwritten signature in black ink, reading "Edward F. Sherer". The signature is fluid and cursive, with the first name "Edward" and last name "Sherer" clearly legible.

Edward F. Sherer
Attorney for Applicants
Registration Number 29,588